

## REMARKS/ARGUMENTS

The rejections presented in the Office action date October 15, 2003 have been considered. Claims 1-10 remain pending in the application. Reconsideration and allowance of the application is respectfully requested.

Claims 1-7 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter, particularly, an abstract idea. The Applicants respectfully traverse the Examiner's rejection. As set forth below, the Examiner has failed to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas, or does not produce a useful result.

The Examiner carries the initial burden of establishing a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas, or does not produce a useful result. M.P.E.P. § 2106(II)(A). Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. *Id.* (emphasis added). The Applicants respectfully submit that the Examiner has failed meet such requirements, and consequently has failed to establish a *prima facie* case.

With respect to independent Claim 1, the Examiner ostensibly takes the position that the claimed invention, as a whole, is devoid of any limitation to a practical application in the technological arts. However, Claim 1 is directed to a practical application in the technological arts. It is not merely reciting an abstract idea. For example, Claim 1 includes various recitations relating to the mapping of database fields, importing investment plan information into database fields, transferring the investment plan information to a central database and from the central database to authorized investment contract sellers, and creating a proposed investment contract from the investment plan information. The Applicants respectfully submit that this clearly defines a practical application, as various practical functions are performed and a proposed investment contract is provided as a result.

As stated by the Federal Circuit, the claimed invention as a whole must produce a "useful, concrete and tangible result." *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368 (Fed. Cir. 1998). The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world value."

M.P.E.P. § 2106(II)(A). The Applicants respectfully submit that, among other claim recitations, the creation of a proposed investment contract clearly exhibits “real world value.” For at least this reason, the invention of Claim 1 and its dependents (Claims 2-7) cannot be considered merely an abstract idea.

As to whether the invention of Claims 1-7 “produce a useful result,” the Applicant respectfully submits that the Examiner has not provided any evidence that the method fails to produce a useful result. When the Office makes a rejection under 35 U.S.C. §101 regarding utility, the Examiner “must expressly state how the language of the claims has been interpreted to support the rejection.” M.P.E.P. § 2106(II)(A) (emphasis added). On page 2 of the Office Action, the Examiner has listed various statutory categories that the Examiner believes Claims 1-7 *not* to be, but has not expressly stated how the language of the claims has been interpreted as is required to establish a *prima facie* case of non-statutory subject matter.

In the Examiner’s listing, the Examiner indicates that the claimed invention is not a specific tangible machine or process for facilitating a business transaction. The Applicant respectfully disagrees, and submits that the invention of Claims 1-7 are indeed directed to a specific tangible process. As set forth by the Federal Circuit, the scope of 35 U.S.C. §101 is the same regardless of the form - machine or process - in which the claim is drafted. *See AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999).

The Applicants respectfully submit that independent Claim 1, and Claims 2-7 which are dependent from Claim 1, are statutory processes for practical applications that produce useful, concrete and tangible results. For at least these reasons, the Applicant respectfully submits that Claims 1-7 are directed to statutory subject matter, and requests withdrawal of the 35 U.S.C. §101 rejection.

Claims 1, 4, 6, and 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,073,104 to *Field* in view of U.S. Patent No. 5,666,553 to *Crozier*. The Applicants respectfully traverse the Examiner’s rejection. It is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness. To establish *prima facie* obviousness based on a combination of references, three basic criteria must be met, as is set forth in M.P.E.P., §2143:

- 1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art references must teach or suggest all of the claim limitations.

As set forth in greater detail below, the Applicants contend that *prima facie* obviousness has not been established, for reasons including the failure of the prior art references (either alone or in combination) to teach or suggest all of the claim limitations, and that a legally requisite motivation to combine such references has not been established.

It is first respectfully submitted that the Examiner has not clearly identified teachings in the cited prior art that correlate to the language of the claims, and therefore has not established that the cited references teach or suggest all of the claim limitations. For example, the Examiner argues that *Field* discloses:

computerized information management system to create and access commercial paper market to sell claims to asset backed commercial paper conduits, defining export (import) showing what data items are in each field in the data file, reading the received export file, download file (import), converting data from provider's format to standard format, transferring data to file(s), transmitting data and reports (proposal), approval (authorization), creation of financial and clinical database, primary file server and second file server, seller accounting system (seller information such as name, ID, etc.), receiving data, storage device, interface...

The Applicant respectfully submits that this listing fails to address the recitations of the claims that the Examiner has rejected. As just one example, Claim 1 includes "defining an import specification identifying database format characteristics of investment plan information stored in a first database." The Applicant submits that defining such an import specification is not taught or suggested by *Field* or *Crozier*, either alone or in combination, nor does the Examiner's rationale for rejecting Claim 1 providing any correlating description from *Field* and/or *Crozier* that teaches/suggests the defining of such an import specification. For the claimed recitation of "importing the investment plan information into the predefined data fields of the second database according to the import specification and data import map," the Examiner appears to correlate *Field* with this recitation by indicating that *Field* "download

file (import).” The Applicant respectfully submits that *Field* does not teach the importing as set forth in Claim 1, and the generic downloading of a file fails to teach or suggest “importing the investment plan information into the predefined data fields of the second database according to the import specification and data import map.”

The Examiner further indicates that *Field* teaches “transferring data to file(s),” and appears to be attempting to correlate this generic transfer of data to one or both of “transferring the investment plan information to a central database accessible by the investment contract sellers authorized by the investment contract buyers to receive the investment plan information,” and/or “transferring the investment plan information from the central database to the authorized investment contract sellers upon initiation by the authorized investment contract sellers.” It is respectfully submitted that transferring data to file(s) fails to read on such claim recitations. For these and other reasons, the Examiner has not established that a combination of *Field* and *Crozier* actually teaches all the limitations of independent Claim 1, and thus *prima facie* obviousness has not been established.

As set forth in M.P.E.P. §707.07(d), the grounds of rejection are to be fully and clearly stated. It is respectfully submitted that the Examiner’s listing does not fully and clearly indicate which claim recitations, or which of the rejected claims, the various listed items of *Field* pertain to. It is also noted that a plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. M.P.E.P. § 707.07(d). The Examiner has rejected Claims 1, 4, and 6-10 for the reasons presented in the Examiner’s listing above. Each of these claims recites different aspects of the invention, and it is unclear from the common rejection which items of the Examiner’s listing are purportedly applicable to particular ones of the Claims 1, 4, 6, 7, 8, 9 and 10. If the Examiner maintains the rejection, the Applicants request clarification on which parts of the rejection are being applied to each of these claims.

The Applicant notes that the Examiner identifies various portions of *Field* as teaching particular recitations of the claims. The listing includes the Abstract, Figures 3, 5, 12-13, 23, and C1 L5-L45, C7 L8-L67, C8 L60 to C10-L48. The Applicant respectfully submits that the recited portions of *Field* do not teach or suggest Claim 1 as recited. Because it is unclear which recitations of Claims 1, 4, and 6-10 that the Examiner is arguing are taught

by *Field*, the Applicant has not been afforded a reasonable opportunity to respond more specifically to the Examiner's rejections.

The Examiner admits that *Field* fails to explicitly disclose 1) import; 2) mapping of data fields; 3) releasing information; 4) seller authorization code; 5) notification; and 6) releasing investment information. The Examiner contends, however, that *Crozier* discloses a method for translation of dissimilar-formatted data between computer applications and platforms, and mapping of data fields and data import, citing the *Crozier* Abstract, C3 L1 to C2 L10, and C4 L45-L67. Again, the Examiner has only provided a statement of what *Crozier* purportedly teaches (translation of dissimilar-formatted data between computer applications and platforms, and mapping of data fields and data import), but it is unclear which claim recitations and/or claims the Examiner is referring to. However, the Applicant submits that *Crozier* fails to disclose, either alone or in combination, Claim 1 or its dependent claims. The data translation features of *Crozier* for sharing data between disparate application programs using mapping of data, either alone or in combination with *Field*, do not teach all the limitations of any of Claims 1, 4, 6-10.

With respect to independent Claim 8, the aforementioned arguments apply. Further, Claim 8 includes various "means" for performing functions. The Examiner has not identified corresponding function in the cited references, nor has the Examiner identified corresponding structure for performing the functions. It is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness for Claim 8 and its dependent claims for at least this additional reason.

Another requirement for establishing *prima facie* obviousness is there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Examiner argues that it would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the disclosure of *Field* and include file import to get external data files and translate the data file by mapping to match internal data format for generating target database. This does not provide evidence of motivation to combine the references. Rather, the statement indicates a scenario of what

might happen if one were to combine a portion of *Crozier* with *Field*. It does not, however, indicate what the motivation would be.

It is noted that the Examiner has also indicated that it would be apparent to one skilled in the art that contract information is disclosed to transacting parties “as a prudent business practice.” The Applicant respectfully contends that it is unclear if this statement is providing a purported motivation to combine the *Crozier* and *Field* references. If so, the Applicant submits that “prudent business practice” does not rise to the level of evidence required to establish motivation to combine references. There must be some actual *motivation* to combine the cited references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest *the combination*. Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.* (emphasis added). The examiner must show some objective teaching leading to the combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). It is respectfully submitted that there is no such objective teaching, and it is respectfully submitted that the Examiner has pieced together aspects purportedly found in the prior art to arrive at the invention through hindsight. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

*In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)).

It is respectfully submitted that the Examiner has not established objective evidence leading to the combination, and therefore *prima facie* obviousness has not been established for this additional reason. The Applicant contends that Claims 1, 4 and 6-10 are

allowable over the cited combination of *Field* and *Crozier*, and withdrawal of the rejection thereto is respectfully requested.

Claims 2-3 and 5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Field* as applied to claim 1, and in further view of U.S. Patent No. 6,151,588 to *Tozzoli et al.* (hereinafter *Tozzoli*). The Applicant respectfully traverses the Examiner's rejection.

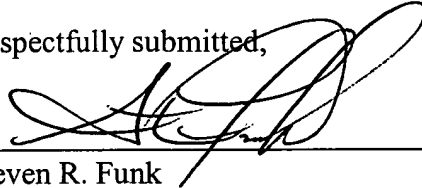
The Applicant first notes that the Examiner has applied only *Field* to the subject matter of Claim 1, and has applied *Tozzoli* to the recited features of dependent Claims 2, 3 and 5. Therefore, the Examiner argues that *Field* by itself teaches or suggests all of the claimed recitations of independent Claim 1, to which Claims 2, 3 and 5 are dependent. As set forth above, *Field* fails to teach or suggest all the limitations of independent Claim 1, and therefore a combination of *Field* and *Tozzoli* cannot teach or suggest any of dependent Claims 2, 3 or 5, as a combination of the references still fails to teach at least that which is set forth in independent Claim 1. For at least this reason, Claims 2, 3 and 5 are not taught or suggested by a combination of *Field* and *Tozzoli*, and Claims 2, 3 and 5 are in condition for allowance.

Further, it is again respectfully submitted that the Examiner's stated motivation to combine *Field* and *Tozzoli* fails to meet the standard for establishing *prima facie* obviousness. The Examiner's stated motivation to combine the references is "to timely inform the user (seller/buyer) of any changes in contract, approval, acceptance, etc." It is respectfully submitted that this does not provide a motivation to combine the references, but rather uses the Applicants' disclosure as a blueprint for piecing together the prior art to defeat patentability. For this additional reason, it is respectfully submitted that *prima facie* obviousness has not been established for the 35 U.S.C. §103(a) rejection to dependent Claims 2, 3 and 5.

**CONCLUSION**

The Applicant respectfully submits that the pending claims are allowable over the cited prior art of record, and that the application is in condition for allowance. If the Examiner believes it necessary or otherwise helpful, the undersigned attorney of record may be contacted at (651) 686-6633 (x110) to discuss any issues related to this case.

Respectfully submitted,



Date: March 15, 2004

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